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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,621	03/07/2001	Bernard G. Freeland	A2A-101	7479
7590	02/02/2006		EXAMINER DASS, HARISH T	
David I. ROCHE Baker & McKenzie 130 E. Rondolph Drive Chicago, IL 60601			ART UNIT 3628	PAPER NUMBER

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/800,621	Applicant(s) FREELAND, BERNARD G.	
	Examiner Harish T. Dass	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/21/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (hereinafter Anderson – 5,774,883) in view of “GartnerGroup Says eBay and AutoTrader.com Partnership Should Improve Conversion Purchasing Rates for Online Used Cars”, Business Editors/High-Tech Writers. Business Wire. New York: Mar 7, 2000. pg. 1 (hereinafter - Business Wire).

Re. Claim 1, Anderson discloses validating a titled asset to be sold by a seller to a buyer [see entire document particularly, Abstract], arranging for financing by a lender of funds to be paid to a seller for said asset on behalf of a buyer [Figures 12-13a, 14; C1 L64 to C2 L12], all of said steps taking place without an intermediate transfer of ownership of said asset from said seller to any party other than said buyer [C2 L6-L9]. Anderson does not explicitly disclose providing an escrow service for ensuring that financial and legal aspects of said sale occur in an orderly manner. However, Business Wire discloses this step [see entire document particularly, Pp1 pgraf # 1, Pp 2 pgraf # 11] to protect online transaction of car buying service. It would have been obvious at the time the invention was made to a person having

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ordinary skill in the art to modify the disclosure of Anderson and include providing an escrow service, as disclosed by Business Wire, to establish high level of confidence in buyers' and sellers' minds by providing additional protection.

Re. Claim 2, Anderson discloses wherein said validation comprises an examination of the asset and creation of descriptive information regarding the asset and its condition, and recording said descriptive information in a report [abstract; C5 L45-L50]. Further, it is well known that when a used car is purchase buy the car dealer, the dealer inspect the car to appraise the car, and when an individual buys a car from another person, he/she takes the car for inspection to auto-repair shop to find out the condition of the car. For example, car max checks every car and provide recommendation.

Re. Claim 3, Anderson discloses wherein said validation comprises an inspection of the asset and a recommendation for repairs or alterations of the asset [C19 L1-L3].

Re. Claim 8, Anderson discloses validating a titled vehicle to be sold by a seller to a buyer, said validating including an inspection of said vehicle to confirm its make, model and condition [Figures 12-13a, 14; C1 L64 to C2 L12; C5 L45-L50], arranging for financing by a lender of funds to be paid to a seller for said vehicle on behalf of a buyer [C18 L25-L57; C26 L1-L23], and all of said steps taking place without an intermediate transfer of ownership of said vehicle from said seller to any party other than said buyer [C2 L6-L9]. Anderson does not explicitly disclose providing an escrow service in which

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an agent coordinates said sale, and makes arrangements for said vehicle and title to said vehicle to be transferred to the buyer, arranges for purchase funds to be given to the seller of said vehicle, and attends to satisfaction of any liens with respect to the seller's ownership of said vehicle, and attends to recordal of any liens to be made by a lender of funds to said buyer on said title. However, Business Wire discloses this step [see entire document particularly, Pp1 pgraf # 1, Pp 2 pgraf # 11] to protect online transaction of car buying service. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Anderson and include providing an escrow service, as disclosed by Business Wire, to establish high level of confidence in buyers' and sellers' minds by providing additional protection.

Re. Claim 9, Anderson wherein said validating comprises preparation of a descriptive information report with recommendations for maintenance, repair and/or alteration of said vehicle [C19 L1-L3].

Re. Claim 10, claim 10 is rejected with same rational as claim 1.

Re. Claim 11, Anderson discloses wherein said validation service comprises an examination of the asset by a technician familiar with assets of the type to be sold, and said technician creates a written report containing descriptive information regarding the asset and its condition [abstract; C5 L45-L50].

Re. Claim 12, Anderson discloses wherein said asset is a vehicle and validation comprises an inspection of the vehicle and a recommendation for repairs or alterations of the vehicle [C19 L1-L3].

Claims 4-7 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson and Business Wire as applied to claims 1, 10 above, and further in view of Finch (US 6,850,902).

Re. Claims 4-7, Anderson discloses wherein said method includes additional steps selected from the group consisting of: providing tag and title services in which requirements for licensing and registration of the asset with governmental officials are fulfilled (documents) [C17 L30-L44; C18 L25-L57], wherein said method includes providing tag and title services in which requirements for licensing and registration of the asset with governmental officials are fulfilled (documents) [C17 L30-L44; C18 L25-L57]. Neither Anderson nor Business Wire explicitly discloses resolving liens held by previous lenders of money to said seller by paying all monies owed lienholders existing at the time of sale, and attending to recordal (history) of new liens associated with borrowing by said buyer, and wherein said method includes resolving liens held by previous lenders of money to said seller by paying all monies owed lienholders existing at the time of sale, and wherein said method includes attending to recordal (history or history record) of new liens associated with borrowing by said buyer. However, Finch

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discloses these features [see entire document particularly Abstract; Figures 2, 4, & 6; C1 L32-L50; C3 L13-L60] to release of a lien formally held by a lender and transfer title to new owner. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Anderson and Business Wire and include resolving liens held by previous lenders, as disclosed by Finch to satisfy the old loans for clean title transfer to new owner.

Re. Claims 13-16, claims 13-16 are parallel claims to claims 4-7 and are rejected with same rationale as claims 4-7.

Response to Arguments

2. Applicant's arguments filed 11/21/2005 have been fully considered but they are not persuasive. Because:

In response to Applicant argument, recitation Claim Rejection - 35 U.S.C. & 101, Rejection of 35 U.S.C. & 101 has been withdrawn.

In response to Applicant argument, recitation, *Business Wire does not qualify as a prior art. Examiner disagrees with the Applicant. Because:*

Priority

It is noted that this application appears to claim subject matter disclosed in prior Application No. 06/187,629, filed 3/7/2000. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For

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benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was

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unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

1-30-06
- Applicant's provisional ~~60~~187,629 was filed on 03/08/2000 a day later than 03/07/2000.

In response to Applicant argument, recitation, Obviousness Rejections under 35 U.S.C § 103(a) as to claims 1-3 and 8-12, Applicant failed to point out a missing limitation, applicant simply compares the invention with prior art.

In response to Applicant argument, recitation, in *Andersen*, the title to the asset has already been delivered from the seller to the automotive dealership, thus the asset has been transferred to a third party. Applicant failed to point out where Anderson discloses transfer of title between buy and seller are excludes. It is known that the title transfer of a property (asset) such as vehicle or real estate is transferred from seller to buyer. Argument that the vehicle title is transferred to dealer, it may be true if the dealer has purchased the vehicle.

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Now the dealer is a new owner. Dealer is either owner of the asset (vehicle) or an agent for processing the transaction and he/she is compensated for the services as a commission.

In response to Applicant argument, recitation, *Business Wire* describe in any detail how "escrow services for ensuring that the financial and legal aspects of said sale occur, It is obvious that auction site to protect the seller interest, it should have assurance from the buyer, where these assurance are well known to member of Ebay auction site, where the buyer and seller are registered and provide personal information as well as opening account, where the buyer has to provide credit card number and authorization, which is an escrow account, once the buyer is satisfied and purchased the item (vehicle), the escrow will got to the seller and the auction site should know the seller has the asset, similarly, the website should protect the buyer that the seller has the asset. It is not different than dealer agent who collects down payment form buyer and the balance from financial institution and forward it to the seller.

Conclusion

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

In response to this office action, applicant should provide a statement, with amendment, that no new matter is added and the amendment complies with original specification. It is preferred to provide the pages in specification where new limitation can be found.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

US 4,876,648 (Lloyd) discloses a system and method for implementing and administering a mortgage plan" discloses a computerized mortgage implementing system includes a central service computer, which helps establish and maintain mortgage plans based upon mortgages at least partially collateralized by investment vehicles. Both a plurality of groups of investment vehicle information and mortgage information are stored in the service computer. Borrower information is entered in the service computer when a mortgage plan is to be established.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

1/27/06


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600